IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

# APPEAL BRIEF FOR THE APPELLANTS

**SAITO, et al.**

Serial Number: **09/621,138**

Filed: **July 20, 2000**

Appeal No. :

Group Art Unit: **3729**

Examiner: **TUGBBANG, Anthony D.**

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PATENT TRADEMARK OFFICE

Date: March 25, 2004

Atty. Docket No. **960474B**

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No:

In re the Application of: **SAITO, et al.**

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P.T.O. Confirmation No.: 3485

For: **GROMMET WATER-PROOFING METHOD AND WIRE-HARNESS LOOSENING JIG**

## BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: March 25, 2004

Sir:

## I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present invention, YAZAKI CORPORATION.

## II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.



## III. STATUS OF CLAIMS

The claims are those presented in the Appendix, claims 7, 8 and 9. Claim 7 is an independent claim and Claim 8 is dependent thereon. Claim 9 is an independent claim.

## IV. STATUS OF AMENDMENTS

In the last amendment, filed June 27, 2003, amendment to claims 7 and 9 were made which were entered. A Request for Reconsideration was filed October 10, 2003 with no further claim amendments made.

## V. SUMMARY OF THE INVENTION

The wire harness loosening jig (60) of claim 7 is in combination with a wire harness and has a base plate (61), a fixing-side clamping portion (62) attached to one end of the base plate having a first pair of clamps (66, 67) for clamping one end of a wire harness, and a guide rail (63) attached to the base plate (61) extending in a longitudinal direction of the wire harness, when the wire harness is arranged in the jig for loosening. A moveable-side clamping portion (64) is provided that is slidably arranged with the guide rail (63) and has a second pair of clamps (68, 69) for clamping an other end of the wire harness. Clampers (70, 71) are arranged to shift one of the first pair of clamps (67) and one of the second pair of clamps (69) in a radial direction of said wire harness to clamp the wire harness, so that when the movable-side clamping portion (64) is moved towards the fixing-side clamping portion (62), the wire harness is compressed and wires disposed therein are loosened. In claim 8, the movable-side (64) can be moved towards the fixing-side clamping portion (62) by a driving mechanism (65). Claim 9 is comparable to claim 7, but where the movable side clamping portion (64) is movable by a driving mechanism (65)

including a screw shaft (73) rotatably supported by a bearing (72) on the side of the base plate (61), a motor (74) for driving the screw shaft (73), and a lever (75) for driving the motor (74).

These claims are clearly supported at page 11, lines 4 to 12, and shown in Figure 15 of the present specification.

## VI. ISSUES

An issue presented is whether the clear description of components of an apparatus can be altered in rejecting claims to an apparatus which clearly has distinct components. More specifically, an issue is presented as to whether the language of a reference specifying a "guide rail" can be tortured to an extent that it is equal to a "base plate". Can clear language in a reference describing an apparatus be mis-characterized in alleging anticipation of claims to a distinct apparatus? Are applicants' claims anticipated by U.S. 4,512,828?

## VII. GROUPING OF THE CLAIMS

The claims 7-9 are to be grouped as one group, and stand or fall together.

## VIII. ARGUMENTS

In the final Office Action, dated August 12, 2003, the Examiner rejects Claims 7-9 on the basis of anticipation under 35 U.S.C. §102(b) by Helm (U.S. 4,512,828), and in the Advisory

Action dated October 24, 2003, the Examiner retained the rejection following a Request for Reconsideration.

The Helm reference is clear in describing the components of a cable holding and positioning apparatus used in splicing large diameter multi-conductor cable end portions to each other. The components include guide rails 32 and 34 that are hollow horizontal guide rails attached to the upper end of the rigid vertical members 26. (See Col. 3, lines 31-33 and the drawings). In the Helm structure, clamping mechanisms 54 and 56 are provided, with mechanism 56 movable along guide rails 32 and 34 (Col. 4, lines 1-2). Rods 186 are provided that are rigid support rods for supporting conductor supports 184, the rods, in turn, supported by extending through apertures disposed in support plates 96 and 98 of the clamping mechanisms 54 and 56 (Col. 6, lines 61-64).

Applicants' claims, in distinction, require, in addition to other components, a base plate, a fixing-side clamping portion attached to one end of the base plate, a guide rail attached to said base plate extending in a longitudinal direction of said wire harness, and a movable-side clamping portion slidably arranged with the guide rail.

In the Office Action and Advisory Action, the Examiner insists that the Helm components are the same as those of Applicants' claims. The Office Action alleges that the guide rail 34 of Helm should be considered as a base plate and that the rail 186 should be considered as a guide rail attached to a base plate.

If, as suggested in the Final Office Action, item 34 is to be designated a base plate and item 186 is to be designed a guide rail (Final Office Action: paragraph 3, lines 3-5), the structure of Applicants' claims is not found or suggested. For example, there is no guide rail attached to a base plate extending in a longitudinal direction of a wire harness as required in Applicants' claims. The rigid support rods 186 of Helm are supported by extending through apertures disposed in the support plates 96 and 98 of the clamping mechanisms 54 and 56 (Col. 6, lines 61-64).

In the Advisory Action, the Examiner states: "First, the structure of the claimed 'guide rail' and 'base plate' does not distinguish over the structure read as the equivalent rail 186 and guide rail 34, respectively in Helm (Attachment to Advisory Action: lines 6-8).

How do hollow horizontal guide rails suddenly become a "base plate"?

Applicants' claims require a base plate and a guide rail attached to the base plate. The Helm reference has no such structure. The Examiner's reliance on In re Schreiber, 44 USPQ2d 1429, 1431-32 (Fed Cir. 1997) is misplaced. While it is correct that that the citation states that while features of an apparatus may be recited either structurally or functionally, and that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, in the present situation the structure is claimed, which is completely different, guide rails vs. a base plate.

In addition, the guide rail is attached to the base plate. The guide rails 186 of Helm are supported by extending through apertures in support plates 96 and 98 of the clamping mechanism 54 and 56. They are not attached to a base plate as required in Applicants' claims.

In an earlier Office Action dated December 31, 2002, the Examiner attempted to equate support frame 22 of Helm with a base plate (Paragraph 3, line 3) and then, in the Final Office Action, switched to attempting to equate a hollow guide rail 34 with a base plate. A plate is defined as a thin, flat sheet or piece of metal or other material. There is no such structure in Helm to which a guide rail is attached.

In the present claimed apparatus (Embodiment 9, Fig. 15), a fixing-side clamping portion 62 is attached to one end of a base plate 61 and the guide rail 63 is also attached to that base plate 61. Such an arrangement is not found in Helm and is impossible to provide because no base plate is present but, rather, hollow guide rails.

In this instance, the Examiner has disregarded, redefined or reconstructed the apparatus of Helm in alleging anticipation of Applicants' claimed apparatus.

In this instance, the Examiner has erred, as stated by the Court in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983) as stated at page 311; "...in considering claims in less than their entireties, Shenck, supra; and in considering the reference in less than their entireties, i.e., in disregarding disclosures in the references that diverge from and teach away from the invention at hand. In re Kuderna, 426 F. 2d. 385, 165 U.S.P.Q. 575 (CCPA 1970)."

Specifically, in this instance, the Examiner has redesigned the disclosed Helm structure in an attempt to negate patentability of Applicants' invention. Such a redesign is impermissible.

## IX. CONCLUSIONS

A reasonable review of the Helm reference and the present claims shows the Applicants' wire harness loosening jig in combination with a wire harness is novel and unobvious.

The appended claims 7-9 are clearly patentable over the cited reference and the rejection thereof should be reversed.

In the event this paper is not timely filed, appellant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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Enclosures: Appendix

## APPENDIX

Claim 7. A wire harness loosening jig in combination with a wire harness comprising:

a base plate;

a fixing-side clamping portion attached to one end of the base plate having a first pair of clamps for clamping one end of a wire harness;

a guide rail attached to said base plate extending in a longitudinal direction of said wire harness, when said wire harness is arranged in said wire harness loosening jig for loosening;

a moveable-side clamping portion slidably arranged with the guide rail having a second pair of clamps for clamping an other end of said wire harness; and

clampers, arranged to shift one of said first pair of clamps and one of said second pair of clamps in a radial direction of said wire harness to clamp the wire harness, so that when said movable-side clamping portion is moved towards the fixing-side clamping portion said wire harness is compressed and wires disposed therein are loosened.

Claim 8. The wire harness loosening jig according to claim 7, wherein said movable-side can be moved towards the fixing-side clamping portion by a driving mechanism.

Claim 9. A wire harness loosening jig in combination with a wire harness comprising:

a base plate;

a fixing-side clamping portion attached to one end of the base plate having a first pair of clamps for clamping one end of a wire harness;

a guide rail attached to said base plate extending in a longitudinal direction of said wire harness, when said wire harness is arranged in said wire harness loosening jig for loosening;

a moveable-side clamping portion slidably arranged with the guide rail having a second pair of clamps for clamping an other end of said wire harness; and

clampers, arranged to shift one of said first pair of clamps and one of said second pair of clamps in a radial direction of said wire harness to clamp the wire harness;

wherein said movable -side clamping portion is movable towards the fixing-side clamping portion, so as to compress said wire harness and loosen wires disposed therein, by a driving mechanism including a screw shaft rotatably supported by a bearing on the side of the base plate, a motor for driving the screw shaft, and a lever for driving the motor.